# FAX TRANSMISSION

**DATE:** August 1, 2008

**PTO IDENTIFIER:** **Application Number** 09/648,111
**Patent Number**
**Inventor:** Kwang-Jo HWANG

**MESSAGE TO:** US Patent and Trademark Office
**FAX NUMBER:** (571) 273-8300

**FROM:** BIRCH, STEWART, KOLASCH & BIRCH, LLP
Robert J. Webster
**PHONE:** (703) 205-8000
**Attorney Dkt. #:** 3430-0131P

**PAGES (Including Cover Sheet):** 8

**CONTENTS:**
Fax Cover Sheet (1 page)
Certificate of Transmission (1 page)
Request for Rehearing Under 37 C.F.R. §41.52 (6 pages)



**BIRCH, STEWART, KOLASCH & BIRCH, LLP**
8110 Gatehouse Road, Suite 100 East, P.O. Box 747, Falls Church, Virginia 22040-0747
**Telephone:** (703) 205-8000 **Facsimile:** (703) 205-8050

Application No. (if known): 09/648,111 Attorney Docket No.: 3430-0131P

# Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office.

on August 1, 2008 .
Date

Signature

Jose Chang
Typed or printed name of person signing Certificate

Registration Number, if applicable

(703) 205-8000
Telephone Number

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

Fax Cover Sheet (1 page)
Request for Rehearing Under 37 C.F.R. §41.52 (7 pages)

PATENT
3430-0131P

**IN THE U.S. PATENT AND TRADEMARK OFFICE**

| | | | |
|---|---|---|---|
| In Re Application of | | Before the Board of Appeals | |
| Kwang-Jo Hwang | | Appeal No. | 2008-0126 |
| Appl. No.: | 09/648,111 | Group: | 2815 |
| Filed: | August 25, 2000 | Examiner: | N.D. Richards |
| Conf. No.: | 5562 | | |

For: METHOD OF PATTERNING A METAL LAYER IN A SEMICONDUCTOR DEVICE

## REQUEST FOR REHEARING UNDER 37 C.F.R. §41.52

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Appellant respectfully requests rehearing of this Appeal with respect to three separate issues:

First, whether the Board decision, in effect, contains a new ground of rejection and whether the Application should be remanded for further proceedings before the Examiner.

Second, whether the Board erred in treating claims 3, 4, 14 and 23 as standing or falling together with the rejections of the other claims on appeal.

Third, whether it was proper for the Board to make a finding of fact on which it based its decision affirming the rejections of record, using Appellant' s disclosure against Appellant.

With respect to the first issue, Appellant respectfully submits that the Examiner failed to make out a *prima facie* case of inherent disclosure of an aspect of the claimed invention by Chen,

and the Board, in an attempt to remedy this deficiency, made an additional finding of fact that was not made by the Examiner in the rejections of record. As a result, Appellant has been denied a fair opportunity to respond to, and present objective factual evidence to rebut, this new finding of fact.

The Board's decision is based a finding of fact, and on conclusions drawn from that finding of fact, which were not made by the Examiner during the entire prosecution history of this Application. Thus, the Board decision affirms the Examiner based not on the underlying reasons presented by the Examiner, but on the Board's independent determination of an additional fact and conclusions drawn from that fact. This belated determination of a new fact, which occurred after the filing of an Appeal brief, Examiner's Answer, and Reply Brief, is believed to deprive Appellant of its right to contest the Board's interpretation of the disclosure in their Application and the Appellant's right to contest what is inherently disclosed by Chen.

Appellant is somewhat handicapped in making this request for rehearing because they have not yet received a copy of the transcript of the hearing. The transcript will clearly show how persistent one APJ was in trying to get Appellant to make an admission against interest concerning the entirely new factual issue raised at the hearing as a basis for affirming the Examiner's position.

The Board's factual finding which serves as the basis for its affirmance of the final rejection is with respect to Appellant' own disclosure, i.e., finding of fact No. 1 on page 6 of the Board decision. This fact concerns the statement in Appellant's disclosure that "[I]n particular Ar or $N_2$ ions physically strike the surface of the metal layer 44, thereby breaking the chemical bonds and lowering the overall binding force of the metal layer."

The Board uses this disclosure of Appellant as a basis for affirming the final rejections of Appellant's claims in the sense that the Board believes that it supports a conclusion that the

Examiner has made a *prima facie* case that Chen inherently discloses the functional claim limitation of lowering the binding force of the metal layer (Board decision, first paragraph on page 9).

Parenthetically, Appellant notes that the Board decision in discussing "inherency," in the "Principles of Law" section of the decision omits mentioning the requirement that before an Applicant has to come forth with evidence rebutting inherency, the Office, e.g., the Examiner, has to make out a *prima facie* case of inherency, i.e., that a particular reference used in the rejection under appeal, has to contain an inherent disclosure, and that disclosure cannot be just possibly present in the reference, or just probably present in the reference, but it must necessarily be present in that reference. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Unfortunately, this new factual finding, which serves as the basis for the Board's conclusion that the Examiner has made out a *prima facie* case of inherency of the claimed invention, and serves as the prime basis for affirming the Examiner's rejection, was raised only at the oral hearing. It was clearly very important to the Board panel involved in this decision because one APJ spent several minutes repeatedly bringing it up and unsuccessfully trying to get Appellant's representative to address it in the form of an admission against interest, which Appellant' representative refused to do, and another APJ also specifically discussed this point during the hearing.

Appellant respectfully submits that a new ground of rejection was made in this Board decision in the sense that a specific part of Appellant' disclosure has been explicitly used against Appellant for the first time by the Board that was not used against Appellant during the entire prosecution of the Application prior to the Board hearing and the Board decision, and that

Appellant must be accorded an opportunity to react to this new thrust of the rejection. Otherwise, Appellant is being unfairly deprived of its administrative due process rights established by the Administrative Procedures Act and by 37 CFR §41.50(b). See, for example, *In re Arkley,* 172 USPQ 524 (CCPA 1972), *In re Kronig and Scharfe,* 190 USPQ 425 (CCPA 1976), and *In re Kumar*, 76 USPQ2d 1048 (Fed. Cir. 2005).

Appellant is being denied an opportunity to address the ramifications of their disclosure which was found by the Board as "Fact 1," serving as a new ground of rejection.

Moreover, because Appellant can present evidence under 37 CFR §1.132 to address this issue, and present arguments concerning differences between their disclosure and Chen's disclosure, Appellant respectfully requests that this Application be remanded to the Examiner for further prosecution before the Examiner.

With respect to the second issue, Appellant respectfully submits that dependent claims 3, 4, 14 and 23 do not stand or fall with the other rejections on appeal. At the oral hearing, Appellant argued that these claims did not stand or fall with the other rejections, and clearly pointed out that their patentability was separately argued, referring to the fact that three separate grounds of rejection were separately argued on appeal. In this regard, reference was made at the oral hearing to the following statement in the Brief on Appeal:

> **"VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**
>
> The first issue presented for review is whether U.S. Patent No. 5,771,110 to Hirano et. al. (Hirano) in view of U.S. Patent No. 6,133,145 to Chen (Chen) suggest all the elements of claims 1, 2, 5-9, 11,13, 15, 16, 20-22, 24 and 28-31 sufficient to support an obviousness rejection under 35 U.S.C. § 103(a).

The second issue presented for review is whether the combination of Hirano, Chen and further in view of U.S. Patent No. 5,968,847 to Ye et al. (Ye) suggest all the elements of claims 10, 17-19 and 25-27 to support an obviousness rejection under 35 U.S.C. § 103(a).

The third issue presented for review is whether the combination of Hirano, Chen and further in view of JP 361002368 to Muraguchi et al. (Muraguchi) suggest all the elements of claims 3, 4, 14 and 23 to support an obviousness rejection under 35 U.S.C. § 103(a)."

Clearly both the Examiner and Appellant argued that there were three separate issues on appeal, one of them being the separate rejection of claims 3, 4, 14 and 23 on different grounds than those used to reject the other claims.

Moreover, as pointed out at the oral hearing by Appellant, if the new finding of fact, i.e., "Fact 1," pertains only to $N_2$, and claims 3, 4, 14 and 23 do not recite $N_2$, but recite $H_2$, and none of the applied references disclose or suggest the use of $H_2$, then the patentability of these dependent claims should be considered separately, especially in view of the fact that the new ground of rejection focuses on $N_2$ and not on $H_2$.

With respect to the third issue, it is well established that an Applicant's disclosure may not be used against Applicant. See *In re Hunman,* 141 USPQ 785 (CCPA 1964), *Ex parte Camarata,* 151 USPQ 739 (Bd. App. 1966) and *Ex parte Ronell,* 138 USPQ 317 (B. App. 1963).

Notwithstanding this general principle, the Board is improperly trying to use Appellant' disclosure against them, based on its first finding of fact, i.e., "Fact 1."

For at least these reasons, Appellant respectfully submits the Board decision is fatally

flawed and should be withdrawn, and the application should be remanded to the Examiner for reopening of prosecution on the merits.

## RELIEF SOUGHT

Appellant respectfully requests that the Board characterize the Decision rendered on June 2, 2008 as constituting a new ground of rejection under 37 CFR 41.50(b), and that the Board should properly review the rejection of claims 3, 4, 14 and 23 separately so that Appellant will have the required fair opportunity to respond to the Board's new "inherency" rationale. Accordingly, Appellant respectfully requests that the Board remand this Application to the Examiner for further prosecution of this Application on its merits.

The Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fee required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Date: August 1, 2008

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: Esther Chong

Esther H. Chong
Reg. No.: 40,953
P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

EHC/RJW:mmi:jmc